

REMARKS**I. Introductory Comments**

No substantive amendments have been made to the claims in this paper. Claim 19 has been amended to correct a minor grammatical error, but no change in claim scope is intended. Therefore, claims 1-14, 16, 18-24, and 26-30 remain pending in the application. Claims 1, 8, and 22 are independent claims. All of the pending claims were rejected by the Examiner.

In the Office Action, the Examiner rejected: (1) claims 1, 2, 4, 5, 7-9, 11, 12, 14, 18-23, and 26-30 under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 6,222,909 (hereinafter "Qua"), and numerous instances of Official Notice taken by the Examiner; (2) claims 3, 10, and 24 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, U.S. Patent No. 5,995,824 (hereinafter "Whitfield"), and the Official Notice taken by the Examiner; (3) claims 6 and 13 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, U.S. Patent No. 6,230,214 (hereinafter "Liukkonen"), and the Official Notice taken by the Examiner; and (4) claim 16 under 35 U.S.C. §103(a) as being unpatentable over the combination of Qua, U.S. Patent Application Publication No. 2002/0023099 (hereinafter "Wendelrup"), and the Official Notice taken by the Examiner.

The Examiner took Official Notice to reject every claim, but provided no supporting documentary evidence, such as a prior art reference or an affidavit. Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03, as discussed in greater detail below.

Accordingly, Applicants respectfully request favorable reconsideration of the presently pending claims. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.

II. Official Notice

The MPEP explicitly states that Official Notice should only be used in limited circumstances. Further, Official Notice should only be used if the Examiner can provide instant and unquestionable documentary support. In addition, the MPEP requires the Examiner to provide such support if the Official Notice is challenged. MPEP § 2144.03. For example, MPEP § 2144.03 clearly states that taking Official Notice to make a rejection should be used “[i]n limited circumstances” and “should be judiciously applied.” More importantly, “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03. The Court of Customs and Patent Appeals (CCPA), predecessor to the Court of Appeals for the Federal Circuit, stated that notice of facts beyond the record must be “capable of such instant and unquestionable demonstration as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). The MPEP offers additional guidance on when taking Official Notice is not appropriate:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091 (CCPA 1979).

“If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP § 2144.03, see 37 CFR 1.104(c)(2). The Federal Circuit has held that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art, without specific factual findings and some concrete evidence in the record to support these findings, will not support an obviousness rejection. *In re Zurko*, 258 F.3d at 1386 (Fed. Cir. 2001).

In the Office Action, the Examiner took Official Notice in many instances, and used Official Notice as a basis to form an obviousness rejection of every pending claim. The Examiner failed to provide any documentary evidence to support even one instance of Official Notice, but merely stated that certain things are “both old and well known in the art.” Office

Action, page 3. As the Federal Circuit stated in *Zurko*, general conclusions without specific factual findings and some concrete evidence will not support an obviousness rejection. Therefore, the Examiner must provide documentary evidence in the next Office Action, or withdraw the obviousness rejections of every pending claim. Furthermore, any such documentary evidence must also comply with the rules and laws of obviousness if the Examiner intends to maintain the obviousness rejections. For example, the Examiner must show that any such documentary evidence can be properly combined with *Qua*, *Whitfield*, *Liukkonen*, and *Wendelrup* in order to maintain the stated rejections.

A. Reappearance Of The Same Official Notice

Applicants also note the curious resurrection of the Examiner's use of Official Notice. Applicants filed this application in 2001. In the Office Action dated November 20, 2003, the Examiner also took Official Notice to reject many of the pending claims. Applicants disputed each instance of Official Notice. The Examiner then withdrew the Official Notice and provided additional prior art references. Applicants antedated these references, and recently antedated the Examiner's primary reference in the response to the Office Action dated June 29, 2007.

Now, almost four years later, the Examiner is again relying on Official Notice to reject all of the pending claims. The Examiner is even relying on Official Notice to the identical subject matter that the Examiner took Official Notice to back in 2003. For example, in the Office Action dated November 20, 2003, the Examiner took Official Notice that "the function of translating is both old and well known in the art." And in the current Office Action, the Examiner is taking Official Notice that "functions for editing and translating" are "both old and well known in the art." Office Action dated 10/18/2007, page 3.

If the Examiner is correct, then surely the Examiner would have produced a prior art reference disclosing such material by now. Applicants disagreed with the Examiner's assertions that such material is "old and well known in the art" back in 2003, and the Examiner withdrew the Official Notice. Applicants continue to disagree today, and respectfully request the Examiner to withdraw the Official Notice and the obviousness rejections based on the Official Notice.

III. Claims 1, 2, 4, 5, 7-9, 11, 12, 14, 18-23 Are Patentable Over The Combination Of Qua And The Examiner's Official Notice

A. Independent Claim 1

The Examiner alleged that independent claim 1 is unpatentable over the combination of Qua and the Official Notice taken by the Examiner. Qua fail to disclose numerous recitations of claim 1, and the Examiner's Official Notice is improper without supporting documentary evidence. First, Qua is directed to an "audio note taking system." Qua, Abstract. The Examiner admits that "Qua does not explicitly say that the plurality of data management functions includes functions for editing and translating." Office Action, page 3. The Examiner then took Official Notice that "this limitation is both old and well known in the art." Office Action, page 3.

As discussed above, the Examiner took almost the identical Official Notice back in 2003. Now, the Examiner has resurrected that Official Notice, and expanded its boundaries to include both editing and translating functions. The Examiner alleges that "functions for editing and translating [a] two-way conversation data stored in [a] remote storage device . . . [are] both old and well known in the art." Office Action, page 3. Applicants disagree. Applicants respectfully request the Examiner to withdraw the rejections of claims 1-7, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Any documentary evidence must also explain how Qua can be properly combined with any such documentary evidence. Without such support, claim 1, and claims 2-7 that depend from claim 1, are in condition for allowance.

B. Dependent Claim 4

Dependent claim 4 recites the "apparatus of claim 1, further comprising a secondary device interface that couples the memory with a secondary device to allow transfer of the two-way conversation data from the memory to the secondary device." The Examiner alleged that Qua discloses this recitation by stating "Regarding claim 4, see column 3 of Qua." Office Action, page 4. However, Qua fails to teach or suggest that the apparatus of claim 1 further comprises a secondary interface.

Qua discloses that "the user may record and store audio notes on a detachable storage unit 120." Qua: col. 3, lines 41-42. Further, Qua discloses that "[i]f the audio note is stored on detachable storage unit 120, the user then has the ability to upload this information to a personal

computer or other such compatible device.” Qua: col. 3, lines 52-55. However, Qua fails to disclose “a wireless communication device,” “further comprising a secondary device interface that couples the memory with a secondary device,” as positively recited in dependent claim 4. Applicants respectfully request the Examiner to withdraw the rejection of claim 4.

C. Dependent Claim 7

Claim 7 recites that “the plurality of data management functions includes functions for searching, linking, downloading, editing, playing back, converting, sending, archiving, and deleting the two-way conversation data stored in the storage location.” The Examiner admitted that “Qua fails to teach the plurality of data management functions includes functions for searching, linking, downloading, editing, archiving, and deleting,” and took Official Notice that “this limitation is both old and well known in the art.” Office Action, page 4.

Again, Applicants disagree that “this limitation is both old and well known in the art.” Office Action, page 4. Applicants respectfully request the Examiner to withdraw the rejection of claim 7, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Furthermore, the Examiner must explain and show that any such documentary evidence can be properly combined with Qua. Without such support, claim 7 is in condition for allowance.

D. Independent Claim 8

The Examiner again used Official Notice in combination with Qua to reject independent claim 8. The Examiner admitted that “Qua does not explicitly say that the plurality of data management functions includes functions for editing and translating the two-way conversation data stored in the remote storage device.” Office Action, page 5. Specifically, the Examiner alleged that “functions for editing and translating the two-way conversation data stored in the remote storage device . . . [are] both old and well known in the art.” Office Action, pages 5-6.

Again, Applicants disagree that “this limitation is both old and well known in the art.” Office Action, pages 5-6. Applicants respectfully request the Examiner to withdraw the rejection of claim 8, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Furthermore, the Examiner must explain and show that any

such documentary evidence can be properly combined with Qua. Without such support, claim 8, and claims 9-14, 16, 18-21 that depend from claim 8, are in condition for allowance.

E. Dependent Claim 19

Claim 19 was amended to correct a minor error in grammar. Amended claim 19 now recites that “the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language.” The Examiner admitted that “Qua does not teach [that] the translating function is conducted by a text translation service that converts at least a portion of the text data from a first language to a second language,” and took Official Notice that “this limitation is both old and well known in the art.” Office Action, page 6.

Again, Applicants disagree that “this limitation is both old and well known in the art.” Office Action, page 6. Applicants respectfully request the Examiner to withdraw the rejection of claim 19, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Furthermore, the Examiner must explain and show that any such documentary evidence can be properly combined with Qua. Without such support, claim 19 is in condition for allowance.

F. Dependent Claim 20

Claim 20 recites that “the two-way conversation data is audio data, and wherein the translating function is conducted by an audio translation service that translates at least a portion of the audio data from a first language to a second language.” The Examiner admitted that “Qua does not teach [that] the translating function is conducted by an audio translation service that translates at least a portion of the audio data from a first language to a second language,” and took Official Notice that “this limitation is both old and well known in the art.” Office Action, page 7.

Again, Applicants disagree that “this limitation is both old and well known in the art.” Office Action, page 7. Applicants respectfully request the Examiner to withdraw the rejection of claim 20, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Furthermore, the Examiner must explain and show that any such documentary evidence can be properly combined with Qua. Without such support, claim 20 is in condition for allowance.

G. Independent Claim 22

The Examiner again used Official Notice in combination with Qua to reject independent claim 22, alleging that “functions for editing and translating the two-way conversation data stored in the remote storage device . . . [are] both old and well known in the art.” Office Action, page 9.

Again, Applicants disagree that “this limitation is both old and well known in the art.” Office Action, page 9. Applicants respectfully request the Examiner to withdraw the rejection of claim 22, or provide an affidavit or other documentary evidence as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Furthermore, the Examiner must explain and show that any such documentary evidence can be properly combined with Qua. Without such support, claim 22, and claims 23-24, and 26-30 that depend from claim 22, are in condition for allowance.

H. Dependent Claims 2, 3, 5, 6, 9-14, 16, 18, 21, 23-24, and 26-30

The Examiner rejected all of the pending claims, including depending claims 2, 3, 5, 6, 9-14, 16, 18, 21, 23-24, and 26-30. Applicants believe that there are also reasons other than those set forth above why these pending dependent claims are patentable. For example, reasons set forth above which overcome each rejection are based in part on the Official Notice taken by the Examiner. Applicants reserve the right to set forth additional and other reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Accordingly, Applicants respectfully request favorable reconsideration of the presently pending claims.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested, and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0041. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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